

REMARKS

Reconsideration and allowance of this application, as amended, is respectfully requested.

This amendment is in response to the final Office Action dated December 16, 2008. By the present amendment, the independent claims 1 and 20 have each been amended to clarify the invention, as will be discussed below.

Reconsideration and removal of the 35 USC §112, second paragraph, rejection is respectfully requested. By the present amendment, independent claims 1 and 20 have each been amended to clarify the write operations, thereby overcoming this rejection. Accordingly, reconsideration and removal of the rejection is respectfully requested.

Reconsideration and removal of the rejection of independent claims 1 and 20, and their respective dependent claims, under 35 USC §103 as being unpatentable over Akiyama in view of Atwood is also respectfully requested. By the present amendment, each of the independent claims 1 and 20 has been amended to clearly define a particular situation in which data is written back to a second memory bank different from the first memory bank. In the case of independent claim 1, this feature is defined in terms of:

“wherein, when this data is written into said semiconductor device from the outside when the second data is written back to one of said plurality of memory banks and said cache memory does not hold a second address at which said third data is to be written, fourth data held in an entry associated with the second address is written back to a second memory bank, different from the first memory bank, included in said plurality of memory banks. “

In terms of claim 20, this feature is defined as:

“wherein, when first data held in said cache memory is written back to one of said plurality of memory banks, and when a first memory bank included in said plurality of memory banks cannot accept an access from the outside due to a write back operation to write second data held in said cache memory, the first, data is written back to a second memory bank, different from the first memory bank, included in said plurality of memory banks. “

As such, it is respectfully submitted that a write back operation to a second memory bank, rather than a first memory bank is defined in each of these independent claims

which is not at all suggested by either Akiyama or Atwood. Therefore, reconsideration and removal of the 35 USC §112, second paragraph, rejection is respectfully requested.

Reconsideration and removal of the obviousness type double patenting rejection of claims 1 – 3 of the present application over claims 1-12 of USP 7,301,791 (which shares one common inventor with the present application) is also respectfully requested. By the present amendment, independent claim 1 has been amended to clarify the write back operation of data to a second memory bank, including the recitations of the third and fourth data. As such, it is respectfully submitted that this amendment serves to patentably distinguish the present claim over the claims of the referenced USP 7,301,791.

In addition, applicants respectfully submit that, under the current conditions, it is required that the USPTO establish two-way obviousness (such as set forth on pages 800-22 through 800-26 of MPEP §804). Specifically, it is noted that the present application was filed almost two years before the '791 patent. As such, the administrative delay in the USPTO with regard to the present case, has caused the present case to be prosecuted much more slowly than the '791 patent, thereby creating the current situation of double patenting, notwithstanding the fact that the present application was filed almost two years earlier. Further, it is noted that because the '791 patent was prosecuted by a different company (specifically, Renesas), it was not possible for the applicants to control the prosecution of that patent to avoid the double patenting situation. Therefore, it is respectfully submitted that, under the provisions of MPEP §804, it is required for the Office Action to establish two-way obviousness, which has not been done in the present case.

More specifically, as set forth in MPEP §804 under the heading "Two-Way

Obviousness”:

“A two-way test is to be applied only when the applicant could not have filed the claims in a single application and there is administrative delay.”

As noted above, the '791 patent was prosecuted by a different company, and, as such, it was not possible for the applicants to have placed all of the claims in a single application. Further, there is clearly substantial administrative delay with regard to the present application, since it was filed two years before the '791 patent, and yet, the '791 patent issued first. Therefore, it is respectfully submitted that two-way obviousness must be established, which has not been done in the present case.

Further, it is respectfully submitted that, under the requirement for two-way obviousness, not only are the claims of the present application patentably distinct from those of the '791 patent, but the claims of the '791 patent are also patentably distinct from the present claims. This is the case because the claims of the '791 patent recite an arrangement in which a first memory device is capable of reading and writing data in parallel in time. This feature is discussed, for example, in column 3, lines 43-52 of the '791 patent. This is a different feature than that claimed by the claims 1-12 of the present application. Therefore, it is respectfully submitted that the present situation is such that each of the present application and the '791 patent defines a separate patentable invention, and, accordingly, reconsideration and removal of the obviousness type double patenting rejection is respectfully requested.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37

CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus,

LLP Deposit Account No. 01-2135 (Docket No. 500.43581X00), and please credit any excess fees to such deposit account.

Respectfully submitted,
ANTONELLI, TERRY, STOUT & KRAUS, LLP

/Gregory E. Montone 

Gregory E. Montone
Registration No. 28,141

GEM/dks
(703) 312-6600